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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,828	05/14/2001	Christopher D. Creech	18512-006010US	9660

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EXAMINER

LOCKARD, JON MCCLELLAND

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,828

Applicant(s)

CREECH ET AL.

Examiner

Jon M Lockard

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 18-19, drawn to polynucleotides, vectors, and host cells, classified in class 435, subclass 69.1, for example.
 - II. Claims 11-15, drawn to polypeptides, classified in class 530, subclass 300, for example.
 - III. Claims 16-17, drawn to antibodies, classified in class 530, subclass 387.1, for example.
 - IV. Claims 10, and 32-33 (each in part), in so far as they are drawn to a method of detecting a nucleic acid, classified in class 435, subclass 6, for example.
 - V. Claims 20-29, and 32-33 (each in part) in so far as they are drawn to methods for identifying a compound that increases or decreases ion flux through a cation channel by measuring a functional effect or methods for detecting protein in a biological sample, classified in class 435, subclass 7.1, for example.
 - VI. Claim 30, drawn to methods for identifying a compound that increases or decreases ion flux through a cation channel by computer modeling, classified in class 702, subclass 027, for example.
 - VII. Claims 31, drawn to a method of modulating ion flux through a CNG cation channel comprising a CNG3B subunit to treat a disease, classification dependent upon compound structure.

Art Unit: 1647

VIII. Claims 34-35, drawn to a method of screening for mutations of a human CNG3B gene through computer analysis, classified in class 707, subclass 6, for example.

2. The inventions are distinct, each from the other because of the following reasons:
3. Each of inventions I, II and III are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the polynucleotides, polypeptides, and antibodies are all physically and functionally distinct chemical entities that have different structures, activities, and functions.
4. Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for Inventions that are directed to different methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Inventions IV, V, VI, VII, VIII, and IX are directed to methods that are distinct both physically and functionally, and are not required one for the other.
5. Invention IV requires search and consideration of a method of detecting a nucleic acid, which is not required by any of the other Inventions. Invention V requires search and consideration of methods for identifying a compound that increases or decreases ion flux through a cation channel by measuring a functional effect, which is not required by any of the other Inventions. Invention VI requires search and consideration of methods for identifying a compound that increases or decreases ion flux through a cation channel by computer modeling,

Art Unit: 1647

which is not required by any of the other Inventions. Invention VII requires search and consideration of methods of modulating ion flux through a CNG cation channel comprising a CNG3B subunit to treat a disease or detecting CNG3B polypeptide, which is not required by any of the other Inventions. Invention VIII requires search and consideration of methods of detecting CNG3B nucleic acids in human tissue, which is not required by any of the other Inventions. Invention IX requires search and consideration of methods of screening for mutations of a human CNG3B gene through computer analysis, which is not required by any of the other Inventions.

6. Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Invention I can be used in the method for detecting nucleic acids of Invention IV but can also be used in a method of making the protein, which is a materially different process.

7. Inventions I and each of V, VI, VII, and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Inventions I and each of V, VI, VII, and VIII are unrelated product and methods, wherein each is not required, one for another. For example, the

Art Unit: 1647

claimed methods of Inventions V, VI, VII, and VIII do not recite the use of the polynucleotide of Invention I.

8. Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Invention II can be used in the method of identify compounds that modulate it of Invention V, but the polypeptides can also be used to generate antibodies, which is a materially different process.

9. Inventions II and each of IV, VI, VII, and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Inventions I and each of IV, VI, VII, and VIII are unrelated product and methods, wherein each is not required, one for another. For example, the claimed methods of Inventions IV, VI, VII, and VIII do not recite the use or production of the polypeptide of Invention II.

10. Inventions III and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

Art Unit: 1647

as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Invention III can be used in the method of detecting the protein of Invention V, but can also be used to modulate the cation channel or purify the polypeptide, which are materially different processes.

11. Inventions III and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Invention III can be used to modulate the cation channel of Invention VII, but can also be used to purify the polypeptide, which is a materially different process.

12. Inventions III and each of IV, VI, and VIII, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Inventions III and each of IV, VI, and VIII are unrelated product and methods, wherein each is not required, one for another. For example, the claimed methods of Inventions IV, VI, and VIII do not recite the use or production of the antibody of Invention III.

13. The examiner has required restriction between product and process claims. Where

Art Unit: 1647

applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Art Unit: 1647

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and/or different classification, restriction for examination purposes as indicated is proper.

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1647

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jon M. Lockard, Ph.D.** whose telephone number is **(571) 272-2717**. The examiner can normally be reached on Monday through Friday, 8:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gary Kunz, Ph.D.** can be reached on **(571) 272-0887**.

The fax number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

JML
June 16, 2004

